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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,856	02/07/2001	Ami Aronheim	01/21605	3362

7590 02/05/2004

c/o ANTHONY CASTORINA
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EXAMINER

MARVICH, MARIA

ART UNIT PAPER NUMBER

1636

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/777,856	ARONHEIM ET AL.	
	Examiner	Art Unit	
	Maria B Marvich, PhD	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 36-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action is in response to a Response to a Restriction Requirement filed 7/29/03. Applicant's election without traverse of Group I (claims 1-35) in the amendment filed 7/29/03 is acknowledged. Claim 36-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter, there being no allowable generic or linking claim.

Drawings

Formal drawings have been submitted which fail to comply with 37 CFR 1.84. Please see the enclosed form PTO-948.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 6, 9, 12, 15, 18, 21, 24, 27, 30 and 33 are vague and indefinite in that the metes and bounds of "a cell substantially lacking Ras activity" or "in said cell substantially only said second polynucleotide" are unclear. The term "substantially" is a relative one not defined by the claim, no single set of conditions is recognized by the art as being "substantial" and because the specification does not provide a standard for

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ascertaining the requisite degree, the metes and bounds of this claim cannot be established

Claims 3, 12, 21 and 30 are vague and indefinite in that the metes and bounds of "further comprising c) independently expressing" are unclear. According to claims 1, 12, 21 and 30, the method steps of step a and b involve "further comprising independently expressing" the second polynucleotide. However steps a) and b) involve expression of both the first and second polynucleotide. Therefore, it is unclear how the second polynucleotide can be "independently expressed" and to what "independently" refers.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-4 of copending Application No. 09/765,298.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 3-4 of Application No. 09/765,298 anticipate

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claims 1 and 6 of the instant application. Claims 1 and 3-4 of the Application No. 09/765,298 fall entirely within the scope of claims 1 and 6 of the instant application. Specifically, the copending claims and the claim of the instant application recite a method of identifying interactions between polypeptides in which a polypeptide that interacts with the plasmalemma (or plasma membrane) and mutant Ras fused to a second polypeptide are expressed in a yeast cell. Phenotypic expression of Ras is indicative of an interaction between the two polypeptides.

Additionally, if a patent resulting from the instant claims was issued and transferred to an assignee different from the assignee holding a patent from 09/765,298, then two different assignees would hold a patent to the claimed invention of 09/765,298, and thus improperly there would be possible harassment by multiple assignees.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 6-8, 18-19 and 24-26 rejected under 35 U.S.C. 102(a) as being anticipated by Takemaru and Moon, The Journal of Cell Biology 149(2), April 17, 2000, pages 249-254, see entire document.

Takemaru and Moon teach expression of pRas(61) Δ F- β catR8-C which is comprised of the activated c-HaRas mutant and β -catenin into the cdc25-2 yeast strain (endogenous ras is inactive) (see e.g. page 25, column 1, paragraph 3). Library cDNAs are fused to the v-Src myristoylation sequence targeted to the plasma membrane (plasmalemma) to identify polypeptides that interact with pRas(61) Δ F- β catR8-C as characterized by Ras activity. A clone expressing CBP was identified upon isolation of a subset of cells (see e.g. page 251, column 1, paragraph 4).

Claims 1, 3, 5-8, 18-19, 21 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Abo and Aronheim, US 6,500,653.

Abo and Aronheim teach expression of a first polynucleotide, i.e. a Chp fusion peptide containing a v-src myristoylation sequence and a second polynucleotide, encoding a Ras fusion peptide PakR-Ras(61) Δ F in cdc25-2. Binding between the two is characterized by Ras activity in the cdc25-2 cell (see e.g. column 17, line 37-56). Specificity of binding was detected by expression of the first polynucleotide and not the second (see e.g. column 24, line 20-24). Library cDNAs are fused to the v-Src myristoylation sequence targeted to the plasma membrane (plasmalemma) to identify polypeptides that interact with pRas(61) Δ F- β catR8-C as characterized by Ras activity. A clone expressing CBP was identified upon isolation of a subset of cells (see e.g. page 251, column 1, paragraph 4). Regulation of the first polynucleotide is under control of a

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gal1 inducible promoter allowing for down regulation of its expression in a galactose dependent manner (see e.g. column 24, line 13-18).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (703) 605-1207. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maria B Marvich, PhD
Examiner
Art Unit 1636

January 9, 2004



JAMES KETTER
PRIMARY EXAMINER